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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,517	11/28/2003	Hiroshi Monden	8017-1110	7591

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EXAMINER	
SHAH, MILAP	
ART UNIT	PAPER NUMBER
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/722,517	MONDEN, HIROSHI	
	Examiner	Art Unit	
	Milap Shah	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/28/03 & 6/17/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 10 is objected to because of the following informalities: In the claim, the phrase "in an information terminal" should be "in the information terminal" to avoid any 35 U.S.C. 112, lack of unity issues, as the terminal should be the terminal of claim 1. Additionally, when changing "an" to "the", it appears the claim may be claiming the same limitation as claim 1, in which case claim 10 is objected to for failing to further limit the invention. Appropriate correction is required.

Claims 28 is objected to because of the following informalities: As described above, claim 28 appears to also fail to further limit the invention as the recitation of the fighting characters of the information terminal battling each other appears to be recited in claim 19, which requires a fighting character to battle another fighting character, which essentially is the same in different wording.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. 35 U.S.C. 101 requires that an invention must produce a useful, concrete, and tangible result. In the instant claims, there appears to be no tangible result being obtained, that is, the claims set a fighting character to battle on an information terminal, but there's no indication of "displaying" the character, which would constitute a tangible result. Thus, currently no tangible result is obtained and it appears the claims are directed to merely a computer process. See MPEP 2106.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonomura (U.S. Patent Application Publication No. 2002/0061781), filed November 6, 2001.

Claims 1, 2, 10, 19, 20, & 28: Tonomura discloses the invention substantially as claimed including an electronic game device (i.e. the information terminal) with a data processing method include the step of setting an image captured by a camera as a fighting character (abstract). Tonomura explicitly lacks a specific disclosure of making the fighting character battle with another fighting character on a screen of the gaming device. However, regardless of the deficiency it would have required only routine skill in the art based on the disclosure of Tonomura as a whole, to set two fighting characters in a battle on the screen of the game device. Tonomura discloses such details as saving multiple characters in memory for use in an "unexpected game" (see at least abstract & figure 8[RAM of Portable Game Device]). Therefore, an artisan having ordinary skill in the art at the time of the invention would have found it obvious to set multiple saved fighting characters in a battle sequence on the screen of the gaming device in order to implement said unexpected game of Tonomura with the fighting characters created by Tonomura's image processing method, where each captured image is given at least attack and defense capability values (see at least abstract, figures 6-8, & paragraphs 0051-0053, 0080-0089 & 0090[last sentence]). Thus, accordingly it would have been obvious to determine a winner based on the set capability values (i.e. at least the attack and defense values) of the fighting characters that are set to battle one another.

Claims 3-9 & 21-27: It is noted that claims 3-9 & 21-27 appear to further describe how capability values are created or set based upon attribute information of the image that was captured by the camera or the surroundings. Tonomura discloses using certain attributes consisting at least of the capacity of the image and the time, day, and month the image was captured. Tonomura appears to specifically lack a disclosure of using voice information collected when the image was captured, an arbitrary digit of the capacity of the image, RGB data obtained by RGB-analysis of the image captured, or vector data obtained by vector-analysis of the captured image. However, regardless of these deficiencies one of ordinary skill in the art would have found it a matter of obvious design choice to use such attributes of an image to set capability values of the image. It is noted that the Applicant's specification discloses each of attributes not used in Tonomura and each of the attributes Tonomura uses as equivalent (paragraph 0011 of Applicant's Summary of Invention). Thus, the Examiner submits that it would have been an obvious matter of design choice given Tonomura to deduce capability values using different attribute information of the captured image. The Applicant has not disclosed that use these specific different attribute information of the captured image solves any stated problem or is for any particular purpose and it appears the system would perform equally well with any attribute information used, such as in Tonomura who appears to only use the file size and time/date attribute information to set capability values. Therefore, it would have been prima facie obvious to modify Tonomura to obtain the invention as specified in claims 3-9 & 21-27.

Claims 11-15 & 29-33: As discussed above in the explanation of claims 1, 2, 10, 18, 19, & 28, making fighting characters battle one another on an electronic game device is established. Further, Tonomura appears to explicitly lack a disclosure of setting two fighting characters to battle across two electronic game devices, in which each electronic game device has a single fighting character to battle one another via a communication link. Regardless of this deficiency, hand-held electronic

gaming is considered notoriously well known in the art, for example the "common knowledge" electronic gaming device known as Nintendo™ GameBoy, which was released over a decade ago (first released in 1989), which allowed multiple electronic game devices to be connected to one another in order to provide players the opportunity to compete against each other with their own electronic game devices. Thus, modifying Tonomura to provide a fighting character on two information terminals where they fight against each other across the two information terminals via a communication link only requires routine skill in the art. Additionally, such a system must require a method of transmitting the fighting characters between the electronic gaming devices, such as via infrared, which Tonomura discloses as a communication link available in his electronic devices (figure 2[infrared communication section 54]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tonomura with common knowledge in the art of providing multiple electronic gaming devices for users to compete against one another with in order to provide a personal and competitive gaming experience where multiple users can create their own characters and fight with one another. Infrared is considered a form of wireless communications (claims 14 & 32). Regarding claims 15 & 33, the characters are stored on a recording medium (i.e. the memory of the game device) before transmission, thus it can be considered they are "written to a recording medium to be transferred".

Claims 16, 17, 34, & 35: Tonomura discloses storing information of the fighting characters on the electronic gaming device including capability values and names of the characters (see at least figure 8 and its related description thereof). The game on the electronic gaming device is considered a "video battle game".

Claims 18 & 36: As discussed above, the winner is established based on capability values, which does not change in the situation where two gaming devices are used and the players compete against each other across two gaming devices as discussed above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Name	Reference	Applicability
Siegel et al.	U.S. Patent Application Publication No. 2003/0134679	Two references (1 application, 1 patent) by Siegel et al. that deal with barcode scanning to generate characters in a game.
	U.S. Patent No. 6,709,336	
Monster Rancher	Game Manual (Attached)	Monster Rancher is a game in which characters are created for game play (i.e. battles, etc) based upon random data obtained from CD-ROMs. Similar character creation method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M.B.S.

SCOTT JONES
PRIMARY EXAMINER